

JAN 20 2004

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PATENT**OFFICIAL**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

STEPHEN MEMORY ET AL

Serial No. 09/778,310

Filed February 7, 2001

)  
 ) HEAT EXCHANGER  
 )  
 ) Group Art Unit 3743  
 )  
 ) Examiner Nihir B. Patel  
 )

**REQUEST FOR WITHDRAWAL OF IMPROPER FINAL**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated January 8, 2004 (Paper No. 15),  
Applicants respectfully request withdrawal of the improper finality of the Office  
Action.

The finality of the rejection is improper because the Office Action  
contains new grounds of rejection that were neither necessitated by Applicants'  
amendment of the claims nor based on the information submitted in an Information

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**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the Commissioner for Patents, Attn: Examiner Nihir B. Patel at 703/872-9306  
on January 20, 2004.

Signature: Karen SandersonName: Karen Sanderson

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Disclosure Statement filed during the period set forth in 37 C.F.R. 1.97(c). See MPEP §706.07(a). The Examiner has presented new grounds for rejecting claim 17, which was amended to independent form in Amendment "B" responsive to the prior Office Action, but was not amended in any way as to substance. In connection with the amendment to independent form, Applicants pointed out the prior rejection was improper because the reference relied upon failed to show slots have flange free edges brazed to the tube runs as recited in claim 17 for the entire pendency of this application. To overcome the shortcomings of the prior rejection, the current Office Action introduces new grounds of rejection based in part on the newly cited reference Shigenaka et al 5,617,916. There was absolutely nothing in the prior amendment that necessitated this new ground of rejection. Rather, the new grounds of rejection was necessitated by the shortcomings of the prior rejection which failed to provide a proper basis for rejecting claim 17 because of its failure to show the structure that has been recited in claim 17 for the entire pendency of this case, i.e., slots having flange free edges. In view of the foregoing, the finality is improper and should be withdrawn.

While the foregoing is sufficient reason to withdraw the finality of the Office Action, Applicants also wish to note that for the first time in the prosecution of this application, the Examiner has indicated that claim 20 has been withdrawn from consideration. The withdrawal from consideration has been done despite the fact that

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the Examiner did consider claim 20 and issued a rejection of claim 20 in the Office Action dated July 8, 2002. The next Office Action (dated March 10, 2003) withdrew the rejection of claim 20 and failed to state any new rejection of claim 20, while noting that other claims were withdrawn. Importantly, this Office Action did not withdraw claim 20. The fact that claim 20 was not withdrawn or rejected was pointed out in Applicants' Amendment "B" filed in response to the prior Office Action and wherein Applicants argued that claim 20 appeared to be in condition for allowance in view of its amendment to independent form. Rather than address this point, the Examiner simply indicates that claim 20 is withdrawn without any comment or rationale. By withdrawing claim 20 at this late date in the prosecution, after having already considered claim 20, rejecting claim 20, and withdrawing the rejection of claim 20, and without comment or rationale as to why claim 20 has now been withdrawn, there has been no opportunity to develop a clear issue between the examiner and the Applicant with respect to the withdrawal of claim 20, which appears to clearly read on the elected invention and species. This is improper in a final rejection. See MPEP §706.07 stating that "before final rejection is in order a clear issue should be developed between the Examiner and the Applicant." For this additional reason alone, Applicants believe finality of the rejection is improper and should be withdrawn.

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In addition to the foregoing, Applicants note that in the prior Amendment "B" they argued that claim 18 had been improperly indicated to be withdrawn and provided a lengthy argument in this regard pointing out that claim 18 read on the elected invention and species. Applicants specifically requested that claim 18 be examined. The present Office Action fails to address these arguments in any fashion and rather simply again, as in prior Office Actions, indicates that claim 18 is withdrawn without comment. Given the arguments and request in the prior amendment, any Office Action that fails to acknowledge and address the arguments and request is improper. This is especially true for a final Office Action. Again, as with claim 20, there has been no opportunity to establish a clear issue with respect to claim 18 between the Examiner and the Applicant because Applicants have no idea as to the Examiner's basis for withdrawing claim 18, which appears to clearly read on the elected invention and species. Accordingly, for this additional reason, finality of the rejection is improper and should be withdrawn.

In addition to the foregoing, Applicants would also request that the Examiner provide a supplement to the Office Action and/or an interview wherein the Examiner's position with respect to withdrawn claims 18 and 20 is explained so Applicants have an understanding of the Examiner's position with respect to these two claims which Applicants believe have been improperly withdrawn from consideration because the claims clearly read on the elected invention and species.

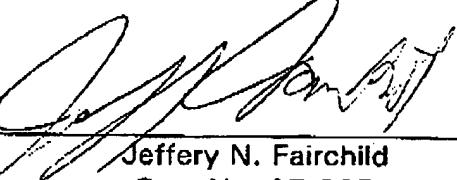
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In view of the foregoing, Applicants respectfully request withdrawal of the finality of the rejection and an early notification of the same so that Applicants have an opportunity to determine how to fully respond to the present Office Action.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,  
CLARK & MORTIMER

By

  
Jeffery N. Fairchild  
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January 20, 2004

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